



# Office Action Summary

Application No.

09/276,935

Applicant(s)

Kliwer et al.

Examiner

Michael Pak

Group Art Unit

1646



☒ Responsive to communication(s) filed on Dec 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-24 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

*Election/Restriction*

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to an isolated human nuclear receptor, classified in class 530, subclass 350.
  - II. Claim 5, drawn to a fusion protein, classified in class 530, subclass 350.
  - III. Claims 6-9, drawn to an isolated nucleic acid, construct, host cell, and method of making host cell, classified in class 435, subclass 69.1.
  - IV. Claim 10, drawn to a method of screening a test compound by binding, classified in class 435, subclass 7.2.
  - V. Claim 11, drawn to a method of screening a test compound by activating, classified in class 435, subclass 375.
  - VI. Claim 12, drawn to a compound that induces, classified in class and subclass varies depending on the structure of the compound.
  - VII. Claim 13, drawn to a compound that activates, classified in class and subclass varies depending on the structure of the compound.
  - VIII. Claims 14-19 drawn to a method of modulating function, classified in class 568, subclass 12.
  - IX. Claims 20-24 drawn to a method of treating disease, classified in class 514, subclass 129.

The inventions are distinct, each from the other because of the following reasons:

The products of inventions I-III and VI-VII are distinct each from the other, because they are drawn to products having materially different structures and functions.

The methods of inventions IV-V and VIII-IX, are distinct, each from the other, because they are drawn to processes having materially different process steps, which are practiced for materially different purposes.

The products of invention of Group I, and the process of Group IV, V, VIII and IX are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the product can be used in the alternative in the processes of Group IV, V, VIII or IX.

The product of inventions II is not used in or produced by the process of inventions IV, V, VIII or IX, and is distinct from each other.

The products of invention of Group III, and the process of Group IV, V, VIII and IX are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP. § 806.05(h)). In the instant case the product can be used in the alternative in the processes of Group IV, V, VIII or IX.

The products of invention of Groups VI and VII, and the process of Group IV, V, VIII and IX are related as products and process of use. The inventions can be shown to be distinct if

either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MEP, § 806.05(h)). In the instant case the products can be used in the alternative in the processes of Group IV, V, VIII or IX.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because the search for each group is not the same as the search for the other groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 5:50 AM to 2:20 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyster, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196

*Michael D. Pak*

Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
20 March 2001